

REMARKS/ARGUMENTS

These remarks are responsive to the Final Office Action dated October 18, 2005. These remarks were necessitated by the Examiner's new ground of rejections and his reliance upon new prior art to sustain his previous rejection of the claims. Applicants believed the Amendment in response to the previous Office Action overcame the rejections. Presently, Claims 1-45 are pending in this case. Claims 1, 8 and 24 are independent.

Summary of Rejections:

In the October 18, 2005 Office Action, the Examiner rejected Claims 1, 8 and 24 under 35 U.S.C. §112 as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the art that the inventor(s) had possession of the claimed invention. According to the Examiner, the "course of action to be taken" expresses within the claim limitation that more than one action is considered, however, the citation to the specification that the applicant provided for support (page 4, ll. 16-18 and throughout the specification) only indicates the recipient's computer recognizes the existence of a correct identifier. "There is insufficient evidence that the identifier indicates a course of action but rather triggers a reaction or a response." Applicant respectfully traverses these rejections.

The Examiner rejected Claims 1-10, 12-19, 21-31, 33-41 and 44-45 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,732,216 Logan et al. ("Logan") in view of U.S. Patent No. 6,259,444 to Palmer et al. ("Palmer"). According to the Examiner, Logan does not explicitly teach wherein the identifier indicates a course of action to be taken with the file, but Palmer teaches an identifier indicating a course of action to be taken with the file. These rejections are respectfully traversed for at least the reasons set forth below.

35 U.S.C. §112

In the October 18, 2005 Office Action the Examiner rejected Claims 1, 8 and 24 under 35 U.S.C. §112. According to the Examiner, the “course of action to be taken” expresses within the claim limitation that more than one action is considered, however, the citation to the specification that the applicant provided for support (page 4, ll. 16-18 and throughout the specification) only indicates the recipient’s computer recognizes the existence of a correct identifier. According to the Examiner, “there is insufficient evidence that the identifier indicates a course of action but rather triggers a reaction or a response.” Applicant respectfully traverses these rejections. The specification of the present application states at page 4, lines 1-5 that “the e-mail may also contain a predetermined identifier detailing the nature of the attached sound file so as to distinguish the sound file from other sound files that may be attached to the e-mail. The predetermined identifier may be a specific name such as ‘vsample.wav’. It may also be an information tag embedded in the e-mail.” It is also stated in the specification that “the mail server could contact the recipient’s voice mail system 60 and leave the attached sound file as a message in the voice-mail.” (Page 5, ll. 18-22). Another possible action disclosed is that “the content of the e-mail may be converted from text to voice. Upon receipt of the sender’s e-mail the attached sound file could be used as a voice sample to convert the e-mail text to voice.” (Page 6, ll. 9-11). Accordingly, the disclosure of the “information tag” along with the various possible actions associated with the sound file clearly supports the fact that Claims 1, 8 and 24 were supported by the specification as amended. The above notwithstanding, Claims 1, 8 and 24 have been amended to recite that the predetermined identifier “distinguishes said sound file from other files attached to the message.” There is support for this amendment in the above cited portions of the specification. This amendment also would not necessitate a new search as the

amended language merely clarifies the original claim language “predetermined identifier indicating an aspect of the sound file.” The claims as amended are clearly supported by the specification. Accordingly, applicants respectfully request that the Examiner reconsider and withdraw his 35 U.S.C. §112 rejections.

35 U.S.C. 103(a)

The Examiner rejected Claims 1-10, 12-19, 21-31, 33-41 and 44-45 under 35 U.S.C. 103(a) as being unpatentable over Logan in view of Palmer. These rejections are respectfully traversed.

Claim 1 of the present invention, as currently amended, recites an electronic message having a sound file and a predetermined identifier that distinguishes the sound file from other files attached to the message and indicates a course of action to be taken with the sound file.

Logan describes an audio program distribution system in which a host system organizes and transmits program segments to client subscriber locations. Program segments are associated with descriptive subject matter segments, and the subject matter segments may be used to generate both text and audio cataloging presentations to enable the user to more easily identify and select desirable programming. (*See Abstract*)

In contrast to the present invention, the identifier in Logan is used to mark a location within a program segment and does not distinguish one file from another or identify how to treat the program segment. For example Logan uses an identifier to bookmark a program segment so that it can be later retrieved from storage. “By bookmarking a program segment, that segment may be recalled by the subscriber and all or part of it saved for later use in local storage, from which it may be reproduced, forwarded as an attachment to an email message, and the like.” (*See Col. 15, lines 15-19*) Logan also uses an identifier to tag the beginning and ending of the

audio file. "These tags are translated into the "H" and "E" recorded pairs in the selections file which identify the beginning and ending of the phrase in the audio file." (See Col. 44, lines 12-15) In addition, Logan uses an identifier to indicate a position in the recording. "[I]dentification data includes the specification of a chosen position in said selected audio recording to which said audio annotation relates" (See Col. 45, lines 52-54) In all of the examples presented above, Logan discloses an identifier to mark a location in the sound file not to distinguish one sound file from another.

Palmer also fails to disclose a predetermined identifier which distinguishes an attached sound file from other files and indicates an action to perform on the sound file. Thus, Palmer fails to cure the deficiencies of Logan. Additionally, it is improper to combine Logan and Palmer in the manner suggested by the Examiner.

In Palmer, the identifier that the Examiner is attempting to employ refers to a physical event identifier. When a physical event occurs, if the identifier matches that event then a predefined action occurs. (Col. 6, ll. 13-36). This identifier does not distinguish one file attached to an email from another. Thus, since Palmer also fails to disclose an identifier which distinguishes a file attached to an electronic message from another attached file and fails to indicate an action to be performed on that file, Claim 1 is not rendered obvious by Logan, Palmer or the combination thereof.

Claims 8 and 24 are not rendered obvious for similar reasons as those discussed with regard to Claim 1. Accordingly, the rejections to Claims 1, 8 and 24 are respectfully traversed. Examiner is requested to reconsider and withdraw his 35 U.S.C. §103(a) rejections of Claims 1, 8 and 24.

Claims 2-7, 9-10, 12-19, 21-23, 25-31, 33-41 and 44-45 depend from Claims 8 and 24 respectively. As such these claims are novel over Logan, Palmer and the combination thereof for at least the reasons discussed above. The Examiner is respectfully requested to reconsider and withdraw his rejections of Claims 2-7, 9-10, 12-19, 21-23, 25-31, 33-41 and 44-45.

Improper to Combine References:

The Examiner asserts that it would have been obvious to combine the teachings of Palmer with the system of Logan. However, there is no suggestion or motivation to combine the teachings except the present invention. Logan is directed to an audio program and message distribution system in which a host system organizes and transmits program segments to client subscriber locations. Logan employs identifiers which identify locations within a program. Palmer employs an identifier which identifies that a physical event takes place. These identifiers thus serve very different purposes and thus the only motivation to combine them would be the present specification. Additionally, as discussed above, even if these were combined in the manner suggested, the identifiers do not distinguish one file attached to an electronic message from another file attached to the same message. Thus, one skilled in the art, facing the problems that the Applicants faced would not combine these references as the Examiner suggests and would not come up with the invention that the applicants which the applicants conceived.

The combination of Logan and Palmer does not support a case of obviousness as suggested by the Examiner and the rejection is respectfully traversed. The Examiner is respectfully requested to reconsider and withdraw his rejection of the Claims.

Other Matter

No new matter has been added.

The claims currently presented are proper and definite. Allowance is accordingly in order and respectfully requested. However, should the Examiner deem that further clarification of the record is in order, we invite a telephone call to the Applicants' undersigned attorney to expedite further processing of the application to allowance.

Dated: New York, New York
December 19, 2005

Respectfully submitted,



Richard M. Lehrer
Reg. No.: 38, 536
MINTZ LEVIN COHN FERRIS
GLOVSKY AND POPEO, P.C.
Chrysler Center
666 Third Avenue
New York, New York 10017